Remarks

Claims 1-45 are pending when last examined. Claim 1 is amended to more particularly point out and distinctly claim Applicant's invention. Claim 46 is added. Therefore, Claims 1-46 are pending.

Claim 46 is newly presented. Support for Claim 46, may be found, for example, at page 10, lines 14-22.

Claims 1-45 are rejected under 35 USC § 101 as being directed to non-statutory subject matter. The Examiner states:

> Claims 1-45 are directed entirely towards a database and a directory, said components forming data structures and non-functional descriptive material. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

> The Examiner notes that the Applicant Specifications Page 1 indicate that the invention is related to application computer programs. The Examiner does not detect an embodiment wherein the search engine is embodied as a computer program in a hardware device.

> With respect to the *transaction tracking service, search engine* and other services and tools, the said *transaction tracking service* and *search engine* appear to be embodied as computer programs. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

As amended, Claim 1 now recites that the "subscriber profile database [is] provided in a computer readable medium ..." Accordingly, the Examiner's rejection is believed overcome.

Claims 1-8, 10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 2006/0041505) in view of Coleman (US Publication 2007/0083438).

Regarding Claim 1, the Office Action states:

> Claims 1-8,10,13 rejected under 35 U.S.C. 103(a) as being unpatentable over Enyart (US Publication 200610041505) in view of Coleman (US Publication 200710083438).

> Enyart disclosed a fee-based messaging system wherein the customer is a sender of information, and the client is a recipient of this customer information.

> Enyart disclosed (re. Claim 1) a system comprising: a subscriber profile database including electronic addresses (Enyart-Paragraph 21, *'database includes a registry of possible message recipients')* and biographical and affinity information of subscribers to the system (Enyart-Paragraph 1006, *'opt in to receive paid email messages from vendors')* ; and a electronic address directory for retrieving from the subscriber profile database electronic addresses of selected subscribers. (Enyart-Paragraph 66, *'select list of recipients')*

> Enyart disclosed a form of permission-fee based email system because the client (recipient) is accepting payment from the sender in exchange for ensuring that the sender's message is acted upon by the client (recipient). The Examiner notes that in permission-based email exchanges a receiver is allowed to opt-in to receive messages only from specified sources (sender). Furthermore Enyart Paragraph 66 disclosed a need for a sender (advertiser) to select a list of recipients. Enyart would have been motivated to search for disclosures regarding means for said sender to specify a search criterion for selecting users (intended recipients) that have granted permission to receive from said sender. By following the permission-based rules for selecting

> recipients and sending offers, Enyart avoids having the sender implementing mass mailings (Enyart-Paragraph 65) and the sender avoids being marked as a SPAM sender (Enyart-Paragraph 11 97). The Examiner further notes that Enyart penalizes recipients who do not act on the advertisers' messages (Enyart-Paragraph 63). Thus in implementing the search criterion for selecting users (intended recipients) Enyart also avoids penalizing recipients and avoids irritating those users who have no interest in the sender's offer.

> While Enyart substantially disclosed the invention, Enyart did not explicitly disclose (re. Claim 1) *a transaction tracking service which tracks each subscriber's registration*

messaaes.

While Enyart substantially disclosed the invention, Enyart did not explicitly disclose (re. Claim I) selecting subscribers based on a search criterion selecting a specified biographical or affinity profile.

Coleman disclosed (re. Claim 1) *a transaction trackinq service which tracks each subscriber's resistration messages.* (Coleman-Figure 8, Paragraph 97-1 00, Px 1 03, *'the profiles of only those registered users who meet certain criteria will be presented to the advertisers'*)

Coleman disclosed *a search enaine for retrievina profile information, including electronic addresses of selected subscribers.* (Coleman-Paragraph 81 ,*'searching if a registered user having specific information'*)

Furthermore Coleman disclosed (re. Claim I) selecting subscribers based on a search criterion selecting a specified biographical or affinity profile. (Coleman - Paragraph 20-21 , Paragraph 58,' *advertisements may be presented to only certain potential purchasers who meet requirements set by the advertiser')*

Enyart and Coleman are analogous art because they present concepts and practices regarding email systems implementing permission-based direct email marketing. At the time of the invention it would have been obvious to a person of ordinary skill in the networking art to combine Coleman into Enyart. The motivation for said combination would have been to enable aggregating a pool of purchasers for linking to sellers. (Coleman-Paragraph 9)

Thus, the Examiner substantially repeated his contentions made in the previous Office Action of September 3, 2008. In the Amendments of June 5, 2008 and March 2, 2009, Applicant pointed out that Claim 1's "transaction tracking service which tracks each subscriber's registration messages," is disclosed or suggested by neither Enyart nor Coleman. In response, the Examiner states in the present Office Action:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *'avoid mistakenly rejecting messages and to learn the on- line shopping behavior the subscribers')* are not recited in the

rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

The Examiner notes that each potential purchaser is required to register in order to be recognized as such. Furthermore Coleman disclosed a potential user signing up for a deal which is equivalent to a registration process. Since Coleman involves updating profiles with new information regarding the said deals, wherein the new information is captured during the sign-up process *('registration')* then Coleman disclosed tracking responses to registration messages.

Furthermore Coleman disclosed *a search enaine for retrievina profile information ,includina electronic addresses of selected subscribers.* (Coleman-Paragraph 81, *'searching if a registered user having specific information'*)

Coleman Paragraph 108 disclosed wherein only profiles having certain criteria are provided to the advertisers.

Thus Enyart-Coleman fully disclosed *a subscriber profile database including electronic addresses and biographical and affinity information of subscribers to the system; a transaction tracking service which tracks each subscriber's registration messages; and one or more search enaines which operate the transaction tracking service and an electronic address directory; wherein, in response to a query of the electronic address directory, the search engines retrieve from the subscriber profile database electronic addresses of selected subscribers based on a search criterion selecting a specified biographical or affinity profile.*

Applicant respectfully submits that the Examiner is mistaken. Coleman's paragraph [0081] merely discloses an electronic file which stores information provided by a potential purchaser in response to the electronic file's questions or prompts:

[0081] At block 209 of FIG. 7a, the electronic file 11 determines if the potential purchaser is a registered user or a guest. This procedure could involve simply asking the potential purchaser or, alternatively, asking for certain information about the potential purchaser and then searching to determine if a registered user having that specific information is registered in the electronic file 11. If the potential purchaser is not registered, the guest may be prompted to register with the system proprietor, as depicted in FIG. 4. If the potential purchaser is a registered user, the electronic file 11 may determine whether additional levels of information (i.e., level 1, level 2, level N) is required for the specific deal. ...

Such information is not what is recited as being tracked by the transaction tracking service of Applicant's Claim 1. To further clarify, Claim 1 is now amended to clearly recite that what is being tracked are registration messages received by the subscriber at one or more of his/her email addresses collected in the subscriber profile database, and not simply information regarding interests and shopping habits collected by questions and prompts by the subscription service:

> 1.   A system comprising:
>
> a subscriber profile database provided in a computer readable medium including electronic addresses and biographical and affinity information of subscribers to the system;
>
> a transaction tracking service which tracks registration messages received by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database; and
>
> one or more search engines which accesses the transaction tracking service and the subscriber profile database; wherein in response to a query for electronic addresses, the search engines retrieve from the subscriber profile database electronic addresses of selected subscribers based on a search criterion selecting a specified biographical or affinity profile.
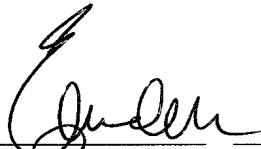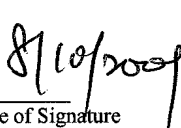
The registration messages received are typically sent to subscriber by email after the subscriber has actually registered at a particular service or vendor. The registration messages are not limited to the subscription service that operates the transaction tracking service. The registration messages document actual interests or purchase habits of the subscriber, more than any questionnaire (e.g., Coleman's) may be able to collect from the subscriber. Therefore, Applicant's Specification explains, at page 10, lines 14-22, tracking such information provides particularly valuable to potential advertisers. Accordingly, Applicant submits that Claim 1 and its dependent Claims 2-9, 10 and 13 are each allowable over the combined teachings of Enyart and Coleman. Reconsideration and allowance of Claims 1-8, 10 and 13 are therefore requested.

The Examiner rejected under 35 U.S.C. § 103(a) Claim 11 as being unpatentable over Enyart, in view of Coleman, further in view of U.S. Patent Application 2006/0229934 ("Law"); (b) Claim 12 as being unpatentable over Enyart, in view of Coleman, further in view
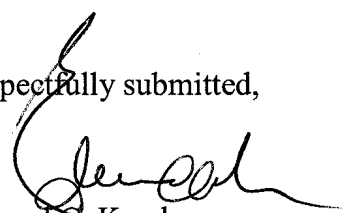
of Law, further in view of Kubik (U.S. Patent 6959324), (c) Claims 14-21, 24-26, 31-33, 37-45 as being unpatentable over Enyart, in view of Coleman, further in view of Goodwin (U.S. Publication 2003/0163485). (d) Claims 22-23 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of Fratkina (US Publication 2005/0055321); (e) Claim 34 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of Karamchedu (US Publication 2004/0201625); (f) Claims 27-30 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of Moskowitz (US Patent 7280982); (g) Claim 35 as being unpatentable over Enyart, Coleman in view of Moskowitz; Claim 9 as being unpatentable over Enyart, in view of Coleman, further in view of Sweeney (US Publication 2005/0004837); and (i) Claim 36 as being unpatentable over Enyart, in view of Coleman, in view of Goodwin, further in view of Sweeney (US Publication 2005/0004837). However, as each of Claims 9, 11-12 and 14-45 each depend from Claim 1, these claims are each allowable over the combined teachings of Enyart and Coleman for the reasons already set forth above. As none of Law, Kubik, Goodwin, Fratkina, Karamchedu, Moskowitz, or Sweeny is believed to disclose "a transaction tracking service which tracks registration messages received by each subscriber at one or more of the subscriber's electronic addresses included in the subscriber profile database," Claims 11-12, and 14-45 are each allowable over the various combinations of teachings on which the Examiner relied for these rejections. Reconsideration and allowance of Claims 11-12 and 14-45 are therefore requested.

Claim 46 is believed allowable for substantially the same reasons.

Thus, all pending claims (i.e., Claims 1-46) are believed allowable. The Examiner is requested to telephone the undersigned Attorney for any questions the Examiner may have regarding the above at the telephone number below.

Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's electronic filing system on August 10, 2009.

_____   8/10/2009
Attorney for Applicant(s)   Date of Signature

Respectfully submitted,

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